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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,887	07/03/2001	Raghavan Rajagopalan	MRD-61	2188

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EXAMINER
LUKTON, DAVID

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/898887			

EXAMINER	
ART UNIT	PAPER NUMBER
	20050501

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Please see the attached communication regarding the amendment filed 2/25/05.

SUBSTITUTE PTOL-90

Pursuant to the directives of the response filed 2/25/05, claims 15, 37, 40, 41, 43 have been amended. Claims 15-46 remain pending.

Applicants amendment filed 2/25/05 is held to be "non-responsive". The issue is one of restriction.

Up to this point, the invention was that of performing a phototherapeutic procedure. Now applicants are changing the invention to recite a method of performing a type I photosensitizing procedure. This change in invention will require a new search and examination. When the claims were drawn to a method of performing a phototherapeutic procedure, the examiner bore the obligation of determining whether there was a suggestion in the prior art that the compounds (to which the claims are drawn) could be used to treat a disease when administration of the compound was coupled with light activation. In addition, the examiner bore the obligation of supporting his assertions of "unpredictability" with examples from the prior art showing that one cannot actually predict the outcomes of photodynamic therapy. Thus, a considerable measure of time has been expanded to search for references in support of §103 rejections, and perhaps more important, a considerable measure of time has been expanded to search for references which would support the examiner's assertion of "unpredictability" (in the treatment of human disease). Now applicants are attempting to impose upon the examiner a new set of obligations.

First, the §103 rejections with respect to the instant claims will be different. No longer must the prior art references teach or suggest that a human disease can be successfully treated. The motivation now could be some sort of diagnostic procedure. Or perhaps just an academic study to determine what the consequences of generating radicals at a given anatomical or cellular site might be. Or perhaps the objective is photoaffinity labeling. Or perhaps there is motivation to apply the compounds to the hair or skin of a mammal, or to the exoskeleton of an insect or the shell of a shellfish, followed by exposure to ordinary sunlight. Thus, while the compounds may be the same, the objectives are not. Then there is the matter of enablement. Applicants have shown that a compound falling outside the scope of the disclosed genus is effective to reduce viability of Lewis Lung carcinoma cells. Perhaps if applicants had tested a compound falling within the scope of the disclosed genus, a similar reduction in viability would have occurred; or perhaps not. But even if it is true that the compounds (to which the claims are drawn) are effective to reduce viability of Lewis Lung carcinoma cells, it does not follow therefrom that the compounds are effective to exhibit a type I photosensitization. Perhaps the mechanism of action (of reduced cell viability) is type I photosensitization. Or perhaps it is a "type II" mechanism. Or perhaps it is some other process entirely. Thus, the claimed invention lacks enablement, although the reasons for this are different from what they were when the claims were drawn to a method of performing a phototherapeutic procedure. Thus, after

applicants have received a search and examination for the first invention (claims of 2/3/04 and 6/24/04) applicants are now attempting to impose upon the examiner the burden of searching for a new invention. In addition, the examiner now bears the obligation of providing a discussion as to why it is that one cannot "predict" the occurrence of a type I photochemical process based upon the observation of a reduction of cell viability. A new search for references to support the points of the discussion would also have to be undertaken. Thus, the invention now claimed is a non-elected invention; as such, the amendment filed 2/25/05 is non-responsive.

Notwithstanding the foregoing, in the event that applicants choose to file a request for continued examination, a change in the invention to that which is recited in the amendment filed 2/25/05 would not be precluded.

It is suggested that applicants return to the previously examined invention (claims of 2/3/04 and 6/24/04); a final rejection will then be issued.

✧

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.